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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/349,676 07/08/99 ONDECK

K PHA-23.681

EXAMINER

TM02/0910

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INTELLECTUAL PROPERTY DEPARTMENT  
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TARRYTOWN NY 10591

JANVIER, J

ART UNIT

PAPER NUMBER

2162

DATE MAILED:

09/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/349,676

Applicant(s)

ONDECK, KRISTEN DIANE

Examiner

Jean D Janvier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**Response To Applicants' Amendment**

The Examiner approves the new title "POST SALE CUSTOMIZATION  
ACCORDING TO RETAILER'S SPECIFICATIONS"

The Examiner approves the new abstract.

The Examiner does not approve the changes made to the specification because, on page 1 of the amendment in the specification section, system-implemented method was introduced. System-implemented method should apparently be replaced with a computer-implemented method.

Although amended, the rejection of claim 1, or more specifically claims 1-9, under 101 and 112, first paragraph is still maintained. Once again, Applicant is requested to amend the claimed invention so as to allow one of ordinary skill in the art to perform the inventive steps without undue experimentation.

First, Applicant traverses the rejection of claim 1 under 101 and 112, first paragraph. Applicant claims that the rejection is improper since claim 1 had met all the conditions for patentability set forth in Title 35 and requests that the Examiner explain in more details the reason for this rejection so that the claim can be amended accordingly. The Examiner respectfully disagrees with the Applicant's findings. Although a machine is a statutory subject matter, a "machine-implemented method" is a non-functional and non-descriptive subject matter since the combination is broad, vague and thereby making it impossible to one of ordinary skill in the art to perform the inventive steps without undue experimentation. A suggested or preferred combination would have been, if supported, a —computer-implemented method— as known in

the art. Please amend the claim accordingly to overcome the 101 and 112, first paragraph rejection in order to advance prosecution.

Second, Applicant traverses the rejection of claim 1 under 102(e). Applicant states that the customizing in Lemole et al relates to the profile of interest as opposed to commercial activities, as specified in claim 1. Further, the user accessing the CAR server enables the customizing, whereas in the claimed invention the notification about a commercial transaction enables the customizing. Once again, the Examiner respectfully disagrees with the Applicant's argument. In fact, the rejection of claim 1, as it stands in the application, using the Lemole et reference was proper and necessitated by the scope of the claim. Regarding claim 1, Lemole et al teach a system for displaying customized advertising information to a registered customer having access, using a conventional Web Browser such as Internet Explorer running on his client PC 101 of fig.1, to a Customized Advertising Repository Server or CAR Server 111 connected to Internet 103 through HTTP Server 110 or Web Server. The CAR Server 111 stores the customer's advertising repository in a CAR Server database 112. When the user or customer accesses his customized ad repository by either clicking on an icon or inputting a URL through his browser, a composite advertising page is dynamically configured by the CAR Server 111 for that particular user or customer based at least in part on that user's previously provided profile. Furthermore, a portion of that composite advertising page can be dynamically configured on a context dependent basis determined from the particular Web site or sites that the user has accessed prior to accessing the CAR Server 111. The dynamically configured composite page or pages of advertising provided to the user using client PC 101 may contain a plurality of static

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images, streaming banners, 3-D images, animation, video and/or audio clips, using any of the technologies available on the Web for presenting textual and/or visual information. Such a composite page or pages is configured from a database 113 storing such images, banners, animation, etc., from a plurality of advertisers. The customized or personalized page is created by selecting advertisers, from a plurality of subscribing advertisers, and their associated banner ads, images and so on that will be elements of the customized page based on the user's specific areas of interest as determined from the profile, and/or the context dependency. From Such dynamically configured composite page or pages, the user can then click on a particular image, video window, banner, etc., to retrieve, through a hyperlink, further information directly from the advertiser's own Web site or mirror Web site (See abstract and fig.1).

For the reasons cited herein, the previous rejection was proper and it is indeed maintained. Therefore, allowance of the claimed invention as requested by the Applicant has been respectfully denied since the Applicant's argument as presented was not persuasive.

Since the amended claim 1 does not necessitate a new rejection, the previous rejection is maintained as herein submitted and **this action has been made final.**

## **DETAILED ACTION**

### **Status of the claims**

Claims 1-9 are now pending. Claim 1 was amended after the first Office Action.

***Specification***

The disclosure is objected to under 37 CFR 1.71, as being so incomprehensible as to preclude a reasonable search of the prior art by the examiner. For example, the term “machine” should be replaced with --apparatus or system--.

Applicant is required to submit an amendment, which clarifies the disclosure so that the examiner may make a proper comparison of the invention with the prior art. Applicant should be careful not to introduce any new matter into the disclosure (i.e., matter which is not supported by the disclosure as originally filed).

Meanwhile, for examination purpose, the Examiner will give a broad interpretation to the claims.  
The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1 is rejected under 35 U.S.C. 101 because it contains non-functional and non-descriptive subject matter.

Claim 1 is also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either an asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Although a system may be considered as a statutory subject matter, a “system-implemented method” is a non-functional and non-descriptive subject matter since the combination is broad, vague and thereby making it impossible to one of ordinary skill in the art to perform the inventive steps without undue experimentation. A suggested or preferred combination would have been, if supported, a —computer-implemented method— as known in the art. Please amend the claim accordingly to overcome the 101 and 112, first paragraph rejection in order to advance prosecution.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Lemole et al, US Patent 6,009,410.

The applied reference, based upon its earlier effective U.S. filing date, constitutes a prior art under 35 U.S.C.102(e).

As per claim 1, Lemole et al teach a Customized Advertising Repository (CAR) Server 111 of fig.1 connected to the World Wide Web (Internet) 103 of fig.1 accessed by a registered user through his browser using client PC 101 of fig.1 (see abstract). When a registered user can enter a commercial context mode from information seeking work context mode by clicking on an icon or inputting the URL address of the particular CAR server, which stores his customized advertising repository. Upon accessing his customized advertising repository (CAR) via the browser of his computer 101 of fig.1, a composite advertising page or pages, in the form of static images, banners, animation, video and audio clips, is dynamically configured by the CAR Server 111 of fig.1 for that specific user based on that user's demographic and psychographic data provided during registration to the service (CAR) and context dependent basis from previously visited Web sites prior to accessing the service. The user, from such dynamically configured composite page or pages, can then click on a particular image, video window or banner to visit a Web site associated with a particular advertiser's (116-121 of fig.1) such as Delta Airlines 116 of fig.1 engaging in commercial activities such as selling tickets to On-line surfers. (see abstract-col.4, line 59 to col.5 line 22).



As per claims 2, 3 and 4, Lemole et Al teach a plurality of vendors or suppliers or retailers or service providers or advertisers (116-121) connected to the CAR Server 111 of fig.1 via the HTTP Server 110 of fig.1 over the Internet 103 of fig.1 and, engaging in a plurality of on-line commercial activities (see fig.1). A vendor or retailer such as Delta Airlines 116 of fig.1 will use a user's profile data to offer a customized package deal to the user using client 101 of fig.1 connected to the Internet 103 of fig.1 (col.4, line 59 to col.5 line 22). If the user makes a purchase as a result of the package deal offer, the CAR service will automatically update his composite page or pages next time he uses the service.

As per claims 5-9, Lemole et al teach a method comprising the steps of:

5.     Wherein the merchandise **or product or service** is capable of being customized according to a specification from the retailer **such as Delta Airlines 116 of fig.1 that can put together a package deal for a user of the service based upon the users profile data** (col.4, line 59 to col.5, line 22).
6.     Wherein the merchandise is capable of being customized according to input from the customer **such as demographic and psychographic data provided by the customer during registration** (col.4, line 59 to col.5 line 22-see abstract).
7.     Wherein the customizing comprises individualizing a home page or **composite page or pages** for the customer (see abstract).

8. Wherein the individualizing comprises creating an advertisement **banner or video/audio clips associated** with a specific retailer **and stored in Database 113 of fig.1 and accessed by the user upon entering the commercial context (see abstract).**
9. Wherein the advertisement is user-interactive **since the user, while viewing a banner Ad. associated with a particular advertiser, can click on an associated link to visit the retailer's or advertiser's site for more information (see abstract).**

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 5, 724,521 to Dedrick- this reference is a relevant prior art under 102.

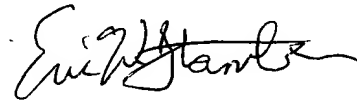
**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (703) 308-6287). The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (703) 305- 8469.

9/6/01

A handwritten signature in black ink, appearing to read "Eric W. Stamber", with a stylized flourish at the end.

ERIC W. STAMBER  
PRIMARY EXAMINER